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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,523	01/16/2004	Paul Anthony Thomas	60130-1987;03MRA0008	7042
26096	7590	12/15/2005	EXAMINER	
CARLSON, GASKEY & OLDS, P.C. 400 WEST MAPLE ROAD SUITE 350 BIRMINGHAM, MI 48009			KING, BRADLEY T	
			ART UNIT	PAPER NUMBER
			3683	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/759,523

Applicant(s)

THOMAS ET AL.

Examiner

Bradley T. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/29/2005 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 17-19 recite "lug portions". The original disclosure fails to provide proper antecedent basis for these limitations and the meaning is not clear. Note that the original disclosure defines lugs 150, however, the

newly recited lug portions do not appear to correspond to those lugs. It is further not clear what is intended to be encompassed by "lug portions".

Claim 20 recites "a substantially curved cross-section". The original disclosure fails to provide antecedent basis and further appears to contradict this limitation. Note the second paragraph of page 5 which describes a planar section with two rounded edges.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, and 4-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 703 378.

EP 0 703 378 discloses an assembly including; a brake caliper having an outboard side; a brake pad 12; a pad spring 26 including a spring planar region; and a pad retainer 32 including a retainer planar region having a first radius for engagement with said spring planar region of the pad spring to restrain radial movement of the brake pad, wherein the pad retainer is secured to the outboard side of the brake caliper at a second radius that is less than the first radius (see figure 3), the pad retainer further including a crook (see figure 3) at an end of the retainer planar region, wherein a part of the spring planar region engages the pad retainer, thereby defining an engaging region

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of the spring planar region. EP 0 703 378 lacks the lateral edge region of the engaging region adjacent to the outboard side of the brake caliper being rounded. The examiner takes official notice that it is well known to round the edges of sheet metal elements to remove sharp edges. It would have been obvious to one of ordinary skill in the art at the time the invention was made to round the edges of the spring of EP 0 703 378 to reduce the sharpness of the edge, thereby increase safety in the assembling and handling of the device.

Regarding claims 7-8, see figure 1.

Regarding claim 15, note that EP 0 703 378 has a constant width, therefore any portion of the spring can be considered to define a maximum width.

Regarding claims 9-12, EP 0 703 378 further lack the specific crook radius dimension. It is noted that the instant disclosure fails to indicate any criticality in the dimension and further teaches that the ranges may be broadened. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize various crook radii of EP 0 703 378 depending on the size of the brake assembly and thickness of the retainer to facilitate manufacture (thicker materials will bend to greater radii) and reduce stress concentrations in the element. Also note, *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

Claims 16-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 703 378 as applied to claim 15 above, and further in view of EP 0 744 559.

EP 0 703 378, as applied above, discloses all the limitations of the instant claims with exception to a wider engaging portion (or lug portions as best understood, note the 112 1<sup>st</sup> rejection above). A widened engaging portion is well known in the art and further demonstrated by EP 0 744 559. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a wider engagement area as demonstrated by EP 0 744 559 in the device of EP 0 703 378 to increase the stability of the spring as it slides against the retainer, thereby preventing jamming and ensuring proper braking operation.

### ***Response to Arguments***

Applicant's arguments filed 4/06/2005 have been fully considered but they are not persuasive.

Regarding EP 0 703 378, the Examiner maintains that it would have been obvious to round all the edges of spring 26, and one would be motivated to do so as set forth in the rejections above. Applicant's arguments have been considered, but it is not clear how "a lateral edge region" differs from the inboard or outboard edges of the spring. It is maintained that the rejections are proper. It is further noted that Applicant has not challenged the statement of Official Notice. The statement has been taken as admitted prior art. Note MPEP 2144.03 C.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley T. King whose telephone number is (571) 272-7117. The examiner can normally be reached on 11:00-7:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan can be reached on (571) 272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BTK

 12/14/05  
**BRADLEY KING  
PATENT EXAMINER**